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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,368	10/16/2003	Robert Condon	105129-3	9292
21125	7590	07/24/2006	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				GUIDOTTI, LAURA COLE
ART UNIT		PAPER NUMBER		
		1744		

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/687,368	CONDON, ROBERT
	Examiner Laura C. Guidotti	Art Unit 1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
 - 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 October 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01222004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a tip resistant wet/dry vacuum, classified in class 15, subclass 327.6.
 - II. Claims 10-13, drawn to a kit for creating a tip-resistant wet/dry vacuum, classified in class 15, subclass 246.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the vacuum itself has a hose that is coupled to a vacuum that includes an outlet and does not include a connector member, an extension hose, or a mating element. The subcombination has separate utility such as it is capable of being used with a vacuum that does not have at least one caster.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Lisa Adams on 19 July 2006 a provisional election was made with traverse to prosecute the invention of group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 Lines 11-12 require "...an outlet adapted to deposit fluid and/or debris adjacent to *the top end of the lower portion* of the housing..." However, Claim 6 Lines 1-2 (which depends from claim 1) require that "...the outlet of the hose is coupled to a port formed in the sidewall adjacent *the bottom end of the lower portion* of the housing." It is unclear to the Examiner as to how an outlet (of the hose) can be positioned such

that it is adjacent to the top end *and* also be coupled to a port adjacent the bottom end of the lower portion of the housing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jankowski, US 5,511,280.

Jankowski discloses the claimed invention including a housing having an upper portion (28) containing a motor assembly (Column 4 Lines 5-6), and a lower portion having a collection tank adapted to retain fluid and/or debris therein (10), the lower portion including a top end (uppermost end of 11 including 12 as shown in Figure 1), a bottom end (lowermost end of 11 including 14, 15 as shown in Figure 1), and a sidewall extending therebetween (central portion of 11), at least one caster mated to the lower portion of the housing to allow a rolling movement of the housing (16, mounted via 15), and a hose (19 or 29) having at least a portion coupled to the sidewall adjacent to the bottom end of the lower portion of the housing (see Figure 1 where hose inlet 17 is coupled to the lower portion; Column 3 Lines 40-45, see Figures 3-4), such that a pulling force applied to the hose will be transferred to the bottom end of the lower portion of the housing to prevent tipping of the housing (Column 2 Line 63 to Column 3 Line 5), the hose further including an outlet adapted to deposit fluid and/or debris

adjacent to the top end of the lower portion of the housing (see Figures 1-2, near clamp 26) wherein the fluid and/or debris is capable of being collected in the collection tank (see Figure 1, Column 4 Lines 36-44, 60-62). Regarding claim 2, the outlet of the hose is coupled to a port formed in the sidewall adjacent to the top end of the lower portion of the housing (26; see Figures 1-2), the port being in communication with the collection tank (Figure 1), and wherein a portion of the hose is connected to the sidewall adjacent the bottom end of the lower portion of the housing (as shown in Figure 1). Regarding claim 3, there is a mating element to mate a portion of those to the sidewall adjacent to the bottom end of the lower portion of the housing (shown in Figures 3-4, includes elements 20, 21, 22, 23, and 24). Regarding claim 4, the mating element is capable of being removably mated to the sidewall of the housing (as 23 and 24 are capable of being uncompressed or the mating element is capable of being removed by breaking; Column 3 Lines 51-60). Regarding claim 5, the mating element is a fastener (gasket 22 that is held by nuts 23 and 24). Regarding claims 6-9, the outlet of the hose (in this instance of claims 6-9, hose 29 as shown in Figure 5, wherein the outlet is connected to 17) is coupled to a port (lower end of 17, see Figure 5) that is formed in the sidewall adjacent the bottom end of the lower portion of the housing (Figure 5, end of 17 is "in" the sidewall), there is an extension hose (in this instance hose 19) disposed within the lower portion of the housing and including a first end coupled to the port (Figures 1, 5) and a second end disposed adjacent the top end of the lower portion of the housing for delivering fluid and/or debris to the collection tank (see Figure 1, Column 4 Lines 36-44, 60-62; second end is shown particularly in Figure 2), there is a mating element adapted

to mate the second end of the extension hose to an internal surface of the sidewall adjacent the top end of the lower portion of the housing (mating element is 26, 27 as shown in Figure 2), and the mating element is considered to be a clamp, clip, strap, or fastener (26).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

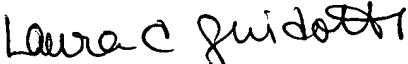
US 3,996,641 to Eichholz discloses the claimed invention including a housing having an upper portion (housing of 36, Figure 3) containing a motor assembly (36), and a lower portion having a collection tank adapted to retain fluid and/or debris therein (24), the lower portion including a top end (28), a bottom end (26 including 38), and a sidewall extending therebetween (central wall portion of 24), at least one caster mated to the lower portion of the housing to allow a rolling movement of the housing (42), and a hose (16) having at least a portion coupled adjacent to the bottom end of the lower portion of the housing (via 50, Figures 1, 5a-5b), such that a pulling force applied to the hose will be transferred to the bottom end of the lower portion of the housing to prevent tipping of the housing (Column 4 Line 40 to Column 5 Line 13), the hose further including an outlet adapted to deposit fluid and/or debris adjacent to the top end of the lower portion of the housing (the outlet is 80, 20; Column 6 Lines 35-38) wherein the fluid and/or debris is capable of being collected in the collection tank (24). Eichholz does not include that the hose is coupled to *the sidewall* adjacent to the bottom end of

the lower portion of the housing. Also, Eichholz does not include that the outlet of the hose being coupled to a port formed in the sidewall.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Guidotti whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Laura C Guidotti
Patent Examiner
Art Unit 1744